

Docket No.: 42390P8718

**REMARKS**

**35 U.S.C. § 102 Rejection**

***Frantz et al.***

The Examiner rejected claims 11-12 under 35 U.S.C. 102(b) as being anticipated by the patent Frantz et al. (5,802,169).

Said claims 11-12 have been canceled herein without prejudice to their subsequent reinstatement.

***Armistead et al.***

The Examiner rejected claims 15-26 under 35 U.S.C. 102(e) as being anticipated by the patent Armistead et al. (6,553,117).

The patent to Armistead does not teach "*at least one or more of the parallel resistors being disposed within the IC*" and "*wherein a desired impedance is provided by a combination of the resistance of the IC and an external terminating impedance external to the IC*" as recited in independent claim 15 and its dependent claims 16-21 as amended herein. Furthermore, the patent to Armistead does not teach that "*the programmable resistor is disposed within an integrated circuit to couple to the transport medium*" and "*wherein the effective impedance is provided by a combination of the programmable resistor and a terminating impedance external to the integrated circuit*" as recited in independent claim 22 and its dependent claims 23-26 as amended herein. It is therefore believed the rejection should be withdrawn in view of the amendments.

**35 U.S.C. § 103 Rejection**

***Frantz et al.***

The Examiner rejected claim 1 under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of Frantz et al. (5,802,169).

The Applicant respectfully points out that the Examiner did not set forth a *prima facie* obviousness rejection as described in MPEP §§ 2142 and 2143 since the Examiner did not show how the cited reference provide any motivation or suggestion to combine

Docket No.: 42390P8718  
Appl. No.: 09/660,255

Docket No.: 42390P8718

the references, nor did the Examiner set forth any expectation of success of the asserted combination.

The Examiner's attention is kindly directed to MPEP § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Furthermore, the Applicant kindly points out to the Examiner that as provided in MPEP § 2143:

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, the Examiner must not rely upon the Applicant's disclosure to establish the suggestion to combine and the expectation of success. It should also be noted that the Examiner's statement that "*it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of an integrated circuit comprising a programmable resistor, as taught by Frantz, into view of prior art in order to improve the maximum the power transfer of a subscriber line interface*" is merely a generic statement of a problem and thus does not establish a motivation or suggestion to combine the cited references. How is does the Examiner's statement suggest one to combine "*an integrated circuit comprising a programmable resistor*" with "*an external*

Docket No.: 42390P8718  
Appl. No.: 09/660,255

Docket No.: 42390P8718

*resistor coupled in parallel with the programmable resistor to provide a first effective impedance to substantially match an impedance of the first transport medium*" as recited in claim 1? The Examiner has not provided such an explanation.

Since the Examiner did not provide any such suggestion or motivation to combine the cited references, and since the Examiner did not provide any expectation of success, a *prima facie* obviousness rejection was not set forth, so the rejection should be withdrawn.

***Frantz et al. in view of Armistead et al.***

The Examiner rejected claims 13-14 under 35 U.S.C. 103(a) as being unpatentable over Frantz et al. (5,802,169) in view of Armistead et al. (6,553,117).

Said claims 11-12 have been canceled herein without prejudice to their subsequent reinstatement.

***Frantz et al. in view of Armistead et al.***

The Examiner rejected claims 2-10 under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of Frantz et al. (5,802,169) as applied to claim 1 above, and further in view of Armistead et al. (6,553,117).

As with the rejection of claim 1, the Examiner did not set forth a *prima facie* obviousness rejection since the Examiner as argued with respect to the rejection of claim 1. Since the Examiner made the same statement "*to improve the maximum power transfer of a subscriber line interface*" the same arguments made with respect to claim 1 likewise apply with respect to claims 2-10 so the rejection should be withdrawn.

**References Made of Record but Not Relied Upon**

The Examiner cited the following references but did not apply these references as a basis for any rejection to the claims: Dahan et al. (6,611,580); Gorcea et al. (6,665,399), Madonna et al. (5,596,569) and Kwon (6,330,138).

Docket No.: 42390P8718  
Appl. No.: 09/660,255

10

Docket No.: 42390P8718

**Conclusion**

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

**Invitation for a Telephone Interview**

The Examiner is invited to call the undersigned attorney, Kenneth J. Cool, at (408) 850-1229 if there remains any issue with allowance.

Respectfully submitted,  
INTEL CORPORATION

Date:

6/9/04



Kenneth J. Cool  
Reg. No. 40,570

Kenneth J. Cool  
Blakely, Sokoloff, Taylor & Zafman, LLP  
12400 Wilshire Boulevard, 7<sup>th</sup> Floor  
Los Angeles, California 90025-1026  
Tel: (408) 850-1229  
Fax: (408) 716-2586

Docket No.: 42390P8718  
Appl. No.: 09/660,255

11